

Application/Control Number: 09/827,888  
Art Unit: 2194

Docket No.: PALM-3588

### **REMARKS**

Reconsideration and allowance are respectfully requested in view of the foregoing amendment and the following remarks.

Claims 29-53 remain pending, claims 33, 42 and 50 having been amended.

#### **Non-Final vs. Final Office Action**

In the Office Action Summary, the present Office Action is indicated as being non-Final. However, on page 8 of the Office Action, the present Office Action is indicated as being Final. Applicants note that the response of August 3, 2005 was filed with all new claims and with a RCE. Therefore, Applicants submit that the present Office Action is correctly indicated as being non-Final in the Office Action Summary.

#### **Rejection of Claims 33, 42 and 50 under 35 U.S.C. 112**

On page 2 of the Office Action, the Examiner rejected claims 33, 42 and 50 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amended the word "executed" to "executing" in claims 33, 42 and 50 to correct an error in the claims. Applicants submit that the amendment to the claims does not change the scope of the claims.

Applicants submit that the amended claims are not indefinite and respectfully request that the rejection of claims 33, 42 and 50 be withdrawn.

#### **Rejection of Claims 29-30, 32-33, 35-39, 41-42, 44-47, 49-50 and 52-53**

On pages 2 and 3 of the Office Action, the Examiner rejected claims 29-30, 32-33, 35-39, 41-42, 44-47, 49-50 and 52-53 under 35 U.S.C. 103(a) as allegedly being

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unpatentable over U.S. Patent No. 5,796,397 to Kusano in view of U.S. Patent No. 6,061,711 to Song et al. ("Song"). Applicants respectfully traverse the rejection.

Independent claim 29 is directed to a method of performing context switching in a portable processing device. The method includes, among other things, displaying a task switching menu listing only ones of a plurality of programs installed on a portable processing device that are useful to execute based at least partly on a currently executing program.

Applicants submit that Kusano fails to disclose or suggest this feature.

Kusano, at col. 1, line 56 through col. 2, line 7, identified a problem in the prior art with respect to entering input data into a different application than one that is currently executing. Kusano, at col. 1, line 56 through col. 2, line 7, discloses:

A conventional pocket-computer requires a user to previously designate what application is used and then to enter data for said application. To change the application for which the input data shall be used or registered during the inputting operation, the user must perform the following steps of: (1) temporarily storing a character string of currently inputted data within a clip board; (2) interrupting or finishing the data inputting operation; (3) switching over to another application; (4) bringing into the state for inputting data for the actuated application; and (5) pasting the character string (data) stored in the clip board. Furthermore, if the preceding application and the new application have different input items, the clipped data shall be classified and separately pasted to corresponding items, i.e., input data stored before the application change can not be pasted as entire data to an input of the new application. It is, therefore, laborious to use once inputted data for any different application.

Kusano, at col. 2, lines 10-19, discloses:

A primary object of the present invention is to provide an information processing device which is capable of easily changing a current application to another on a composite input screen with a menu of input items including selection of kinds of applications, whereby an input data item being inputted in one application mode is easily converted into input data item for another application, and which is capable of effectively using input data which is common or equivalent for both applications by reflecting said data to the data content of the new application.

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Thus, Kusano is concerned with providing input to an application other than the currently executing application ( see Figs 5-8 and col. 5, lines 31-44). Kusano discloses that a kind of application may be selected and the input easily converted to data for another application.

As admitted by the Examiner, on page 3 of the Office Action, Kusano does not specifically disclose or suggest listing only ones of a plurality of programs installed on the portable processing device that are useful. Song relates to context switching operations in a multitasking environment having a multi-processor architecture (Song, col. 1, lines 7-10). Applicants submit that neither Kusano nor Song disclose or suggest displaying a task switching menu listing only ones of a plurality of programs installed on a portable processing device that are useful to execute based at least partly on a currently executing program, as required by claim 29.

Kusano, at col.10, lines 24-27, discloses:

According to the present invention, as defined in claim 3, input data items used for the application to be changed with another one are stored in a buffer during the edition of input data, thereby those of input items for the preceding application, which have no matching items in the new application, can be re-used if the replaced application is selected again later.

Thus, as the Examiner stated on page 3 of the Office Action, Kusano discloses that input items that have no matching items in the new application could be re-used. However, Kusano discloses reusing the input items that have no matching items only with the replaced application if it is selected again at a later time.

On pages 3 through 4 of the Office Action, the Examiner suggests that

It would have been obvious to one of an ordinary skill in the art at the time the invention was made, to have modified the teaching of Kusano to list only ones of a plurality of programs installed on the portable processing device that are useful to create a more efficient menu that avoid fruitless attempts that would yield non-matching items as implied by Kusano (i.e. not listing a clock, a calculator, etc. as displayed in Fig. 3 in the switch to application type of Fig. 7).

Applicants disagree.

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Applicants submit that the Examiner used impermissible hindsight to work backward from claim 29 in order to provide a suggestion for this feature. Further, Applicants submit that the Examiner failed to make a *prima facie* case of obviousness.

According to MPEP, section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit that, for at least the above-mentioned reasons, the prior art fails to disclose or suggest the feature required by claim 29. Further, as submitted above, the combination of references, themselves, fail to teach or suggest all of the claim limitations. Therefore, at least the first and the third requirements for establishing a *prima facie* case of obviousness have not been met. In addition, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must be found in the prior art. The Examiner did not provide any prior art that taught or suggested making the claimed invention.

For at least the above-mentioned reasons, Applicants submit that claim 29 is patentable over the cited references and respectfully request that the rejection of claim 29 be withdrawn.

Claims 30, 32, 33 and 35-37 depend from claim 29 directly or as a base claim. Therefore, Applicants submit that claims 30, 32, 33 and 35-37 are patentable over Kusano in view of Song for at least the reasons provided with respect to claim 29 and respectfully request that the rejection of claims 30, 32, 33 and 35-37 be withdrawn.

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Independent claims 38 and 46 recite features similar to those of claim 29 and are patentable over Kusano and Song for at least reasons similar to those provided with respect to claim 29. Therefore, Applicants respectfully request that the rejection of claims 38 and 46 be withdrawn.

Claims 39, 41, 42, 44 and 45 depend from claim 38, either directly or as a base claim, and are patentable over Kusano in view of Song for at least this reason. Therefore, Applicants respectfully request that the rejection of claims 39, 41, 42, 44 and 45 be withdrawn.

Claims 47, 49, 50, 52 and 53 depend from claim 46, either directly or as a base claim, and are patentable over Kusano in view of Song for at least this reason. Therefore, Applicants respectfully request that the rejection of claims 47, 49, 50, 52 and 53 be withdrawn.

#### Rejection of Claims 31, 40 and 48

On page 6 of the Office Action, the Examiner rejected claims 31, 40 and 48 under 35 U.S.C. 103(a) as allegedly being unpatentable over Kusano and Song, and further in view of U.S. Patent 5,675,672 to Bodin et al. ("Bodin"). Applicants respectfully traverse the rejection.

Claims 31, 40 and 48 depend from claims 29, 38 and 46, respectively, and are patentable over Kusano and Song for at least the reasons provided with respect to claims 29, 38 and 46, respectively. Bodin fails to satisfy the deficiencies of Kusano and Song. Therefore, Applicants submit that claims 31, 40 and 48 are patentable over Kusano, Song and Bodin and respectfully request that the rejection of claims 31, 40 and 48 be withdrawn.

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**Rejection of Claims 34, 43 and 51**

On page 7 of the Office Action, the Examiner rejected claims 34, 43 and 51 under 35 U.S.C. 103(a) as allegedly being unpatentable over Kusano and Song, and further in view of Applicants' Admitted Prior Art ("AAPA"). Applicants respectfully traverse the rejection.

Claims 34, 43 and 51 depend from claims 29, 38 and 46, respectively, and are patentable over Kusano and Song for at least the reasons provided with respect to claims 29, 38 and 46, respectively. AAPA fails to satisfy the deficiencies of Kusano and Song. Therefore, Applicants submit that claims 34, 43 and 51 are patentable over Kusano, Song and AAPA and respectfully request that the rejection of claims 34, 43 and 51 be withdrawn.

**CONCLUSION**

Having addressed all rejections of the claims, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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Correspondence Address:  
Customer No. 49637

By: 

Richard C. Irving  
Attorney for Applicants  
Reg. No. 38,499  
Phone: 410-414-3056  
Fax No.: 410-510-1433